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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,353	04/29/2004	Frank Radochonski	A4-1730	3352

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VALPARAISO, IN 46383

EXAMINER

MAI, TRI M

ART UNIT PAPER NUMBER

3727

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/709,353

Applicant(s)

RADOCHONSKI, FRANK

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,8,10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

1. Claims 3-4, 6, and 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention as previously set forth.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the watch being securing to a wristband must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Claims 1, 2, 5, 7, 8, 10, and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaldi in view of Jacks (5341972), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Bonaldi in view of Jacks, and further in view of Lund

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(4682310). As set forth above, Bonaldi meets all claimed limitations except for the watch. It would have been obvious to one of ordinary skill in the art to provide a watch on a wallet. It would have been obvious to one of ordinary skill in the art to provide a watch as taught by Jacks to enable one to tell time.

With respect to the limitation of the clip extending in a direction parallel to the alignment of the securing means, it is submitted that this recitation does not specify any specific orientation of the watch with respect to the clip at all. It is noted that in fig. 5, the clip extending lengthwise in a direction perpendicular to the direction of the posts. The term "alignment" can be construed as either horizontal or vertical alignment, and without any specificities to the orientation of the alignment, the claim set forth is broad and encompassing both orientations. Thus, the combination of Bonaldi in view of Jacks would inherently meet this limitation.

With respect to the new claims 15-17, as set forth above, the term "alignment" can be construed as either horizontal or vertical alignment. The clip in Bonaldi extending lengthwise in a direction parallel to the length of the wallet and considered inherently parallel to alignment to securing means.

Furthermore, it is noted that there are only two orientations with respect to the watch, either horizontal or vertical. To this limited choices, one of ordinary skill in the art would recognize that reorienting the watch require only ordinary skill.

In the alternative, Lund provide additional evidence that it is known in the art to provide a watch on the outer face of a wallet thus making the combination of Bonaldi in view of Jacks much more obvious.

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4. Claims 1, 2, 5, 7, 8, 10, 13, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roman (4903745) in view of Jacks (5341972), or in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Roman in view of Jacks, and further in view of Lund (4682310). Roman teaches a clip that can be used for as a money clip, i.e., "which has a removable clip which can be used in a normal fashion as a money clip" col. (col. 1, ln. 52), Roman meets all claimed limitations except for the watch. Jack teaches that it is known in the art to provide a watch on a wallet. It would have been obvious to one of ordinary skill in the art to provide a watch on a wallet. It would have been obvious to one of ordinary skill in the art to provide a watch as taught by Jacks to enable one to tell time.

With respect to the limitation of the clip extending in a direction parallel to the alignment of the securing means, it is noted that Roman teaches a clip that can be mounted in two directions. Thus, one of these two positions would satisfy the claimed limitation as claimed. Furthermore, as set forth above, it is submitted that this recitation does not specify any specific orientation of the watch with respect to the clip at all. It is noted that in fig. 5, the clip extending lengthwise in a direction perpendicular to the direction of the posts. The term "alignment" can be construed as either horizontal or vertical alignment, and without any specificities to the orientation of the alignment, the claim set forth is broad and encompassing both orientations. Thus, the combination of Roman in view of Jacks would inherently meet this limitation.

Furthermore, it is noted that there are only two orientations with respect to the watch, either horizontal or vertical. To this limited choices, one of ordinary skill in the art would recognize that reorienting the watch require only ordinary skill.

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In the alternative, Lund provide additional evidence that it is known in the art to provide a watch on the outer face of a wallet thus making the combination of Bonaldi in view of Jacks much more obvious.

5. Claims 1, 5, 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil (4705086) in view of Lund et al. (4682310). O'Neil teaches a wallet comprising first and second exterior surface, and at least one pocket within an interior as claimed and a clip. O'Neil meets all claimed limitations except for the watch. Lund teaches that it is known in the art to provide a watch with securing means (the four extending edges of portion 34 in Fig. 3) extending parallel and the watch can be placed on the cover as shown in Fig. 4. It would have been obvious to one of ordinary skill in the art to provide a watch as taught by Lund to provide enable one to tell the time. With respect to the clip extending in a direction parallel to the alignment of the securing means, it is submitted that this recitation does not impart any specific orientation on the clip of O'Neil since the clip is extending in all direction including widthwise. Furthermore, it is noted that the securing means of Lund can be any two parallel edges, thus the combination of O'Neil and Lund would inherently meet this claimed limitation as claimed.

Regarding claim 15, as set forth above, it is submitted that this recitation does not impart any specific orientation on the clip of O'Neil since the clip is extending in all direction including lengthwise direction.

6. Applicant's arguments have been fully considered but they are not persuasive. With respect to the new limitations in the amendment with respect to the alignment, the term "alignment" can be construed as either horizontal or vertical alignment, and without any

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specificities to the orientation of the alignment, the claim set forth is broad and encompassing both orientations.

Furthermore, the new limitations do not impart any specific orientation over any of the clips of O'Neil, Roman, and Bonaldi, since the clips in these references extending in all directions including.

Furthermore, it is noted that there are only two orientations with respect to the watch, i.e., either horizontal or vertical. To this limited choices, one of ordinary skill in the art would recognize that reorienting the watch require only ordinary skill.

With respect to the assertion that the clips in Roman and O'Neil are not for clipping money, as set forth above, Roman teaches the clip can be used to hold money. Furthermore, it is noted that clip in O'Neil is capable of such intended use.

With respect to In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, numerous references suggesting it would have been obvious to one of ordinary skill in the art having a watch on the outside of a wallet including one having two posts as set forth in Jacks.

With respect to the drawing objection, it is noted that 37CFR 1.83 (a) requires the drawings must show **every feature of the invention specified in the claims**. Thus, the securing of the watch and a wristband as set forth in claim 2 must be shown. The objection stands.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tri M. Mai  
Primary Examiner  
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